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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616

21906 7590 05/01/2003

TROP PRUNER & HU, PC  
8554 KATY FREEWAY  
SUITE 100  
HOUSTON, TX 77024

EXAMINER
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TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 05/01/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28, 30-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28 and 30-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/05/2003 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 34, 36, 40 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Snyder et al. (U.S. Pat. 5,784,444).

Regarding claim 34, Snyder et al. ("Snyder") teaches a telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages (i.e., ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figure 6) to replace the caller ID value for the telephone at which the calling card is used (col.4, lines 47-67).

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Regarding claim 36, note col.4, lines 64-67.

Regarding claim 40, Snyder et al. ("Snyder") teaches a telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages (i.e., messages: ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figure 6), one or more of said plurality of messages to be received by a recipient communications devices in place of the respective caller ID value of a telephone at which the calling card is used (col.4, lines 47-67 and col.5, lines 16-32).

Regarding claim 42, note col.4, lines 53-56 and lines 65-67.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744 as cited in the previous Office Action) in view of Snyder et al. (U.S. Pat. #: 5,784,444).

Regarding claim 28, Tasaki et al. ("Tasaki") teaches a telephone calling card comprising:

a memory having stored therein a unique identifying value (i.e., calling account number, card data, etc.), said memory having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling

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card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card (col.1, line 48 – col.2, line 16).

It should be noticed that Tasaki fail to clearly teach said memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used. However, Snyder et al. (“Snyder”) teaches a plurality of predetermined messages such as messages of ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figures 6 and 6A for a purpose of identifying caller by called party.

Therefore, it would have been obvious to one of ordinary skilled in the art the time the invention was made to incorporate the use of such memory stored therein a plurality of predetermined messages, as taught by Snyder, in view of Tasaki, in order to establish a calling card communication with the caller.

Regarding claim 30, Snyder further teaches limitations of the claim as shown in pictures 6 and 6A, col.4, lines 47-53 and col.5, lines 16-32.

Regarding claim 31, Tasaki further teaches limitations of the claim in col.1, lines 53-58.

Regarding claim 32, Snyder further teaches limitations of the claim in col.4, lines 57-56.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744) in view of Snyder et al. (U.S. Pat. #: 5,784,444) as applied to claim 28 above, and further in view of Taskett (U.S. Pat. #: 5,923,734).

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Regarding claim 33, Tasaki and Snyder, in combination, teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or messages printed on the card, as taught by Taskett, into view of Tasaki and Snyder in order to distinguish the message card with other standard calling cards.

7. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. (U.S. Pat. #: 5,784,444) in view of Taskett (U.S. Pat. #: 5,923,734).

Regarding claim 35, Snyder teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for

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a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or messages printed on the card, as taught by Taskett, into view of Snyder in order to distinguish the message card with other standard calling cards.

Regarding claim 36, Snyder further teaches limitations of the claim in col.4, lines 53-56.

8. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. (U.S. Pat. #: 5,784,444) in view of Tasaki et al. (U.S. Pat. #: 4,879,744 as cited in the previous Office Action).

Regarding claim 37, Snyder further teaches the well-known billing format of the calling card (col.4, lines 25-32). Snyder, however, fails to clearly teach said calling card comprising said memory has a storage area therein for holding a value specifying an account balance, the account balance being stored in the memory at a time later than the manufacturing the calling card. Tasaki et al. ("Tasaki") teaches such features in col.1, lines 53-58, col.3, lines 39-46 and col.4, lines 26-32, line 2 for a purpose of allowing caller to make calls without carrying coins or cash. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the memory of the calling card having a storage area therein for holding a value specifying a respective telephone number which is to be called upon

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usage of the calling card, as taught by Tasaki, in view of Snyder in order to use the telephone card as a substitute for cash payment.

Regarding claim 38, note col.1, lines 48-52 and col.1, line 64 – col.2, line 2.

Regarding claim 39, note col.1, line 64 – col.2, line 2.

9. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. (U.S. Pat. #: 5,784,444) in view of Tasaki et al. (U.S. Pat. #: 4,879,744).

Regarding claim 41, Snyder teaches all limitations as claimed above, except for the feature of said memory has a storage area therein for holding a value specifying a respective telephone number that is to be called upon usage of the calling card. However, Tasaki teaches such feature in col.1, line 64 – col.2, line 16 for a purpose of eliminating the labor of manual dialing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of such memory of the card, as taught by Tasaki, into view of Snyder in order to eliminate the labor of manual dialing and quickly establish of a communication.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Although the Schilling (US. Pat. #: 6,170,745) and Friedes et al. (US. Pat. #: 5,521,966) are not applied into this Office Action, they are also called to Applicants attention. They may be used in future Office Action(s). Both these references are also concerned with the claimed scope of the Applicant's invention as followings:



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Schilling teaches a wireless debit card system and method wherein the personal access number on the debit card is used as a predetermined numeric digit message such as a telephone number of a user A's telephone number to make calls at person B's telephone. The person B's telephone number is replaced with the user A's telephone number stored as the personal access number on the person user A's debit card to that the A's telephone number as an accessible telephone number is used for receiving incoming calls at a later time (see col.15, lines 49-67).

Friedes et al. teaches a single smart card having a storage memory for storing a plurality of predetermined messages such as a menu of applications of airline industry, hotel industry, etc. for order services and products and for transactions with such orders (see col.6, line 52 – col.7, line 55).

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 28-42 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

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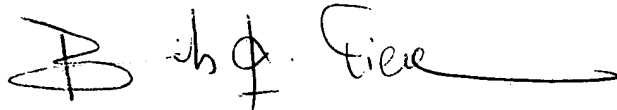
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Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-  
305-4700).

A handwritten signature in dark ink, appearing to read "Binh Tieu", with a long horizontal flourish extending to the right.

**BINH TIEU**  
**PRIMARY EXAMINER**

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Date: April 26, 2003